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EXAMINER

HENNING, MATTHEW T

ART UNIT PAPER NUMBER

2131

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/085,127	Applicant(s) AUDEBERT ET AL.	
	Examiner Matthew T. Henning	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☒ Claim(s) 1-31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/23/02, 6/25/03, 1/13/05, 3/19/05</u> | 6) <input type="checkbox"/> Other: _____ |

1 This action is in response to the communication filed on 10/04/2005.

2 **DETAILED ACTION**

3 ***Election/Restrictions***

4 Applicant's election with traverse of claims 1-18 in the reply filed on 10/04/2005 is
5 acknowledged. The traversal is on the ground(s) that no further burden would be required to
6 search both sets of claims. After further consideration, the examiner finds the applicants'
7 arguments persuasive.

8 Therefore the requirement is has been withdrawn.

9 Claims 1-31 have been examined.

10 ***Title***

11 The title of the invention is acceptable.

12 ***Priority***

13 This application has no priority claimed.

14 Therefore, the effective filing date for the subject matter defined in the pending claims in
15 this application is 03/01/2002.

16 ***Information Disclosure Statement***

17 The information disclosure statement(s) (IDS) submitted are in compliance with the
18 provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure
19 statements.

20 ***Drawings***

21 The drawings filed on 3/1/2002 are acceptable for examination proceedings.

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Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because:

Line 1 recites "This invention provides" which can be implied and must therefore be removed.

Correction is required. See MPEP § 608.01(b).

Claim Objections

Claims 1-31 are objected to because of the following informalities:

Claims 1 and 19 contain multiple periods.

Claims 2, 5-6, 12, 14-15, 27, and 29 do not terminate with a period.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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1 Claims 21-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for
2 failing to particularly point out and distinctly claim the subject matter which applicant regards as
3 the invention.

4 Claim 21 recites the limitation "said at least one second server" in Line 2. There is
5 insufficient antecedent basis for this limitation in the claim.

6 Claim 22 is rejected by virtue of its dependency to claim 21.

7 ***Claim Rejections - 35 USC § 102***

8 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
9 basis for the rejections under this section made in this Office action:

10 *A person shall be entitled to a patent unless –*

11 *(b) the invention was patented or described in a printed publication in this or a foreign country*
12 *or in public use or on sale in this country, more than one year prior to the date of application for*
13 *patent in the United States.*
14

15 Claims 1-2, 4, 8-16, 19-20, 24-28, and 31 are rejected under 35 U.S.C. 102(b) as being
16 anticipated by Davis et al. (US Patent Number 6,105,008) hereinafter referred to as Davis.

17 Regarding claim 1, Davis disclosed a post issuance system for performing data or
18 configuration changes within a PSD (Stored-Value Card See Davis Fig. 1), said system
19 comprising said PSD, including at least one functional application (See Davis Fig. 1 and Col. 1
20 Lines 45-49) and PSD cryptographic means (See Davis Fig. 1 Element 22), a local client
21 functionally connected to said PSD (See Davis Fig. 4 Element 204), a first server functionally
22 connected to said local client (See Davis Fig. 4 Element 206), said PSD and said first server
23 comprising first means for mutual authentication (See Davis Col. 13 Line 47 – Col. 14 Line 13),
24 at least one HSM, including HSM cryptographic means complementary to said PSD

1 cryptographic means, said at least one HSM being functionally connected to said first server (See
2 Davis Fig. 4 Element 218 and Col. 14 Lines 14-38), a communications pipe, established between
3 said PSD and said at least one HSM (See Davis Col. 13 Line 47 – Col. 14 Line 13), storing
4 means for storing or generating said data or configuration changes, said storing means being
5 functionally connected to said first server (See Davis Fig. 11D), said at least one HSM
6 comprising controlling means for controlling said data or configuration changes sent through
7 said communications pipe to said PSD (See Davis Fig. 11D).

8 Regarding claim 19, Davis disclosed a post issuance method for performing data or
9 configuration changes within a PSD (Stored-Value Card See Davis Fig. 1), said method
10 comprising establishing a communications pipe between said PSD and at least one HSM (See
11 Davis Col. 13 Line 47 – Col. 14 Line 13), wherein said PSD is functionally connected to a local
12 client (See Davis Fig. 4 Element 204) and said at least one HSM is functionally connected to a
13 first server (See Davis Fig. 4 Element 218 and Col. 14 Lines 14-38), mutually authenticating said
14 PSD and said first server (See Davis Col. 13 Line 47 – Col. 14 Line 13), selecting at least one
15 functional application within said PSD associated with said existing data or configurations (See
16 Davis Fig. 1 and Col. 1 Lines 45-49), generating or retrieving HSM cryptographic means
17 complementary to cryptographic means included inside said PSD (See Davis Fig. 4 Element 218
18 and Col. 14 Lines 14-38), retrieving said data or configuration changes, processing said data or
19 configuration changes by said first server (See Davis Col. 13 Paragraph 3), encrypting said
20 processed data or configuration changes by said at least one HSM using said complementary
21 HSM cryptographic means (See Davis Col. 15 Line 27 – Col. 16 Line 33 and Fig. 11D), routing
22 said encrypted processed data or configuration changes through said communications pipe into

1 said PSD (See Davis Col. 13 Paragraphs 3-4), and decrypting and processing said processed data
2 or configuration changes by said at least one functional application using said PSD cryptographic
3 means (See Davis Col. 13 Paragraph 5).

4 Regarding claim 2, Davis disclosed a network for the establishment of said
5 communications pipe (See Davis Fig. 4).

6 Regarding claims 4, and 20, Davis disclosed at least one second server in processing
7 communications with said first server, wherein said at least one second server includes stored
8 data or configuration changes retrievable using a PSD unique identifier (See Davis Fig. 4
9 Element 208, Col. 12 Paragraph 1 and Col. 15 Paragraph 2).

10 Regarding claim 8, Davis disclosed a network for the establishment of said
11 communications pipe and for functionally connecting said at least one second server to said first
12 server, and sending means for sending said retrieved data or configuration changes from said at
13 least one second server over said network to said first server (See Davis Fig. 4 and Col. 12
14 Paragraph 1 – Col. 13 Paragraph 3).

15 Regarding claim 9, Davis disclosed that said first server comprises first processing means
16 for receiving and processing said data or configuration changes, and wherein said at least one
17 HSM comprises second processing means for further processing said data or configuration
18 changes (See Davis Col. 13 Paragraph 3 and Col. 15 Paragraph 3 – Col. 16 Paragraph 2).

19 Regarding claim 10, Davis disclosed that said at least one HSM comprises generating
20 means for generating at least one command executable by said at least one functional application
21 (See Col. 15 Line 63 – Col. 16 Line 33).

1 Regarding claim 11, Davis disclosed that said at least one HSM comprises encrypting
2 means for encrypting said at least one command and said data or configuration changes, forming
3 at least one cryptogram (See Davis Col. 16 Lines 20-22).

4 Regarding claim 12, Davis disclosed sending means for sending said at least one
5 cryptogram through said communications pipe into said PSD for processing by said at least one
6 functional application (See Davis Col. 16 Paragraph 2 and Col. 13 Lines 41-63).

7 Regarding claim 13, Davis disclosed that said at least one functional application
8 comprises decrypting means for decrypting said cryptogram using said PSD cryptographic
9 means, and executing means for executing said at least one command (See Davis Col. 13 Lines
10 52-63).

11 Regarding claims 14-15 and 27-28, Davis disclosed that the network is a public or private
12 network (See Davis Col. 6 Line 65 – Col. 7 Line 3).

13 Regarding claims 16 and 31, Davis disclosed that said communications pipe is provided
14 with a secure communications protocol (See Davis Col. 13 Lines 59-61 and Col. 20 Paragraph
15 1).

16 Regarding claim 24, Davis disclosed using a unique identifier associated with said PSD
17 for generating or retrieving said HSM cryptographic means (See Davis Col. 15 Line 63 – Col. 16
18 Paragraph 2).

19 Regarding claim 25, Davis disclosed using a unique identifier associated with said PSD
20 for retrieving said data or configuration changes (See Davis Col. 12 Paragraph 1).

21 Regarding claim 26, Davis disclosed that at least one command executable by said at
22 least one functional application is issued by said at least one HSM, routed through said

communications pipe into said PSD, and processed by said at least one functional application
(See Davis Col. 16 Paragraph 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

*A patent may not be obtained though the invention is not identically disclosed or
described as set forth in section 102 of this title, if the differences between the subject matter
sought to be patented and the prior art are such that the subject matter as a whole would have
been obvious at the time the invention was made to a person having ordinary skill in the art to
which said subject matter pertains. Patentability shall not be negated by the manner in which
the invention was made.*

Claims 5, 6-7, 17-18, 21-23, and 29-30 are rejected under 35 U.S.C. 103(a) as being
unpatentable over Davis.

Regarding claims 5 and 21, Davis disclosed a first and second server communicating
information (See Davis Fig. 4) but did not specifically disclose that they had the capability of
being mutually authenticated. However, mutual authentication between two communicating
network elements was well known in the art at the time of invention and therefore it would have
been obvious to provide the two devices with the ability of mutual authentication. This would
have been obvious because the ordinary person skilled in the art would have been motivated to
protect against illicit access to the contents of the devices.

Regarding claim 22, Davis disclosed using a unique identifier associated with said PSD
for mutually authenticating said PSD and said first server (See Davis Col. 13 Line 47 – Col. 14
Line 39).

1 Regarding claims 6-7, and 23, Davis disclosed using a functional application (See Davis
2 Col. 7 Lines 4-6), but did not specifically disclose that the application was identified by a unique
3 identifier. However, it was well known at the time of invention that applications had unique
4 names which were used to identify them. Therefore, it would have been obvious for the
5 application of Davis would have had a unique identifier used to identify the application.

6 Regarding claims 17-18 and 29-30, Davis disclosed encrypting the signatures in the
7 communications (See Davis Col. 13 Lines 59-61), but failed to disclose the type of encryption
8 used. However, both asymmetric and symmetric encryption were well known in the art at the
9 time of invention and therefore it would have been obvious to the ordinary person skilled in the
10 art at the time of invention to have used either.

11 Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis as applied to
12 claim 1 above, and further in view of DiGiorgio et al (US Patent Number 6,385,729) hereinafter
13 referred to as DiGiorgio.

14 Davis disclosed sending commands to a smartcard from the security card (See Davis Col.
15 14 Paragraph 3), but failed to disclose that the commands were APDU commands.

16 DiGiorgio teaches that APDUs are a standardized way to used to send commands to
17 token devices (See DiGiorgio Col. 9 Paragraph 1).

18 It would have been obvious to the ordinary person skilled in the art at the time of
19 invention to employ the teachings of DiGiorgio in the command system of Davis by sending the
20 commands to the stored-value card using APDUs. This would have been obvious because the
21 ordinary person skilled in the art would have been motivated to follow the standard way of
22 sending commands to a token device.

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Conclusion

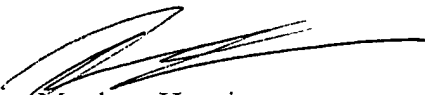
Claims 1-31 have been rejected.

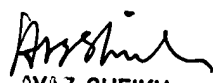
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790.

The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Matthew Henning
Assistant Examiner
Art Unit 2131
1/6/2005


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